

REMARKS

Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier.

Claims 1-25 and 27-53 are now pending in this application.

Claim Rejections - 35 U.S.C. § 103(a)

In Section 6 of the Office Action, claims 1-16, 18-25, 27, 28, 30-48, and 50-53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stewart (U.S. Patent No. 6,970,927) in view of Angelo (U.S. Patent No. 7,051,196). In Section 7 of the Office Action, claims 17, 29, and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of Angelo and further in view of Rusch (U.S. Patent No. 6,801,777).

For the reasons presented below, Applicants submit that Angelo is not available as a prior art reference against claims 1-25 and 27-53.

Inventor and Attorney Declarations

Declarations by each of the inventors pursuant to 37 C.F.R. § 1.131 and a supporting Declaration of the Applicants' attorney have been provided herewith, and provide evidence that the subject matter of claims 1-25 and 27-53 was invented prior to the effective date of Angelo. Angelo was filed on December 5, 2001, as U.S. Application No. 10/006,331.

Supporting Exhibits

Supporting Exhibits have been filed herewith in support of the declarations filed by each of the inventors and the Applicants' attorney.

Exhibit A is a copy of a draft of the present application and an accompanying email that were sent to both of the named inventors prior to December 5, 2001.

Exhibit B is a copy of a set of redacted emails that were sent as of January 8, 2002, indicating that the inventors provided comments on the draft of the present application as of January 8, 2002.

Exhibit C is a copy of the final draft of the present application and an accompanying email that were sent to both of the named inventors on January 9, 2002, requesting that the inventors review the final draft of the application and sign the Declaration and Power of Attorney and Assignment documents that were sent with the final draft of the application.

Exhibit D is a copy of the signed Declaration and Power of Attorney document filed for the present application that indicates that David Kammer signed the Declaration and Power of Attorney on January 17, 2002, and Ray Combs signed the Declaration and Power of Attorney on January 9, 2002.

Conception Prior to December 5, 2001

The Declarations of the inventors and prosecuting attorney submitted herewith, in combination with the Exhibits attached hereto, establish that the subject matter recited in claims 1-25 and 27-53 of the present application was conceived in the United States prior to the effective date of Angelo, coupled with diligence from prior to December 5, 2001, until the filing date of the present application of January 18, 2002. Exhibit A provides evidence that the subject matter of claims 1-25 and 27-53 was conceived prior to December 5, 2001.

In addition to the Supporting Exhibits and Declarations provided herewith, Applicants submit below further details illustrating where the subject matter of claims 1-25 and 27-53 is shown in Exhibit A.

The subject matter of independent claims 1, 18, 30, and 38 is shown in claims 1, 18, 30, and 38, respectively, and paragraphs [0035] and [0036] of Exhibit A.

The subject matter of dependent claims 2-7, 11-17, 19-29, 31-37, and 39-49 is shown in claims 2-7, 11-17, 19-29, 31-37, 39-49, respectively, of Exhibit A.

The subject matter of dependent claims 50-53 is shown in dependent claims 2, 19, 31, and 39, respectively, and paragraph [0023] of Exhibit A.

Diligence from Prior to December 5, 2001

Applicants have provided herewith evidence establishing diligence from prior to December 5, 2001 to January 18, 2002, the filing date of the present application and a constructive reduction to practice. The diligence of 35 U.S.C. 102(g) relates to reasonable “attorney-diligence” and “engineering-diligence” (Keizer v. Bradley, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959)), which does not require that “an inventor or his attorney ... drop all other work and concentrate on the particular invention involved....” Emery v. Ronden, 188 USPQ 264, 268 (Bd. Pat. Inter. 1974). Applicant was diligent in the period between prior to December 5, 2001 and January 18, 2002.

Prior to December 5, 2001 (the effective date of Angelo), a draft of the present application was prepared and sent to the inventors for review. (See Ex. A.). As of January 8, 2002, both inventors had provided comments regarding the draft application. (See Ex. B.). Between prior to December 5, 2001 and January 8, 2002, in addition to performing other duties related to their employment with Palm, Inc., the inventors reviewed the draft of the application. Prior to December 5, 2001, inventor David Kammer provided comments on the draft application to Applicants’ attorney, and on January 8, 2002, inventor Ray Combs provided comments on the draft application to Applicants’ attorney. Ray Combs did not work on the draft application during the time period from December 20, 2001 through January 2, 2002, due to being on vacation during a time in which Palm Inc. was closed from December 25, 2001 through January 1, 2002. On January 9, 2002, a final draft of the application was sent to the inventors (see Ex. C) and was signed by Ray Combs on January 9, 2002, and David Kammer on January 17, 2002. (Ex. D.). The present application was filed on January 18, 2002.

In Reed v. Tornqvist, 436 F.2d 501, 168 USPQ 462 (CCPA 1971), reasonable diligence was found from a time just prior to May 30, 1958 until June 27, 1958 when a draft application was sent to co-inventors on May 6, 1958, an inventor was on vacation from May

9, 1958 until June 9, 1958, the inventor submitted comments on the draft application on June 20, 1958, and the application was filed June 27, 1958. Id. Therefore, reasonable diligence does not require that an inventor or his attorney drop all other work and concentrate on the particular invention involved.

Furthermore, in Haskell v. Coleburne, 671 F.2d 1362, 213 USPQ 192, 195 (CCPA 1982), the court found that “[s]ix days to execute and file application is acceptable.” See MPEP § 2138.06 (citing Haskell v. Coleburne, 671 F.2d 1362, 213 USPQ 192, 195 (CCPA 1982)).

Applicants submit that the subject matter of claims 1-25 and 27-53 of the present application was conceived prior to the effective date of Angelo, coupled with diligence from prior to the effective date of Angelo to the filing of the present application. Therefore, Angelo is not available as a prior art reference, and Applicants respectfully submit that independent claims 1, 18, 30, and 38, and corresponding dependent claims 2-17, 19-25, 27-29, 31-37, and 39-53, are patentable over the cited references.

Withdrawal of the rejection of claims 1-25 and 27-53 is respectfully requested.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

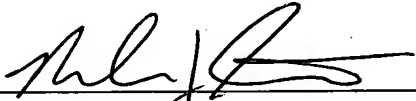
The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for

such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to
Deposit Account No. 19-0741.

Respectfully submitted,

Date 2/5/2008

By 

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